REMARKS

Applicants respectfully request entry of the following amendments and remarks contained herein in response to the Office Action mailed September 24, 2007. Applicants respectfully submit that the amendments and remarks contained herein place the instant application in condition for allowance. Upon entry of the amendments in this response, claims 1 – 21 are pending. More specifically, Applicants amend claims 1 – 8 and 11 – 21. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

I.   Examiner Interview

Applicants first wish to express their sincere appreciation for the time that Examiner Chang spent with Applicants' Attorney, Anthony Bonner, during a telephone discussion on December 14, 2007 regarding the outstanding Office Action. During that conversation, Examiner Chang and Mr. Bonner discussed whether the cited art discloses initiating an Instant Messaging (IM) chat session with the contact in response to determining that the contact is present. Thus, Applicants respectfully request that Examiner Chang carefully consider this response and the amendments.

II.   Rejections Under 35 U.S.C. §101

The Office Action indicates that claims 11 – 21 stand rejected under 35 U.S.C. §101, claiming that the invention is allegedly directed to non-statutory subject matter. Applicants amend claims 11 – 21, as indicated above. Applicants submit that claims 11 – 21, as amended, meet the requirements of 35 U.S.C. §101.

III.   Rejections Under 35 U.S.C. §112

The Office Action indicates that claim 11 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In response to the Office Action request, Applicants amend claim 11, as indicated above. Applicants submit that claim 11, as amended, meets the requirements of 35 U.S.C. §112.

VI.   Rejections Under 35 U.S.C. §102

A.   Claim 1 is Allowable Over *Bernstein*

The Office Action indicates that claim 1 stands rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Publication Number 2004/0128356 ("*Bernstein*"). Applicants respectfully traverse this rejection on the grounds that *Bernstein* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 1 recites:

> A method comprising:
> determining an Internet presence of a contact identified in an email message; and
> initiating an instant messaging (IM) chat session with the contact *in response to determining that the contact is present.*
> *(Emphasis added)*

Applicants respectfully submit that claim 1 is allowable for at least the reason that *Bernstein* fails to disclose, teach, or suggest a "method comprising… initiating an instant messaging (IM) chat session with the contact *in response to determining that the contact is present*" as recited in claim 1. More specifically, *Bernstein* discloses an "Instant Messaging session [that] is initiated via email… the initial chat request is not delivered via an Instant Message, rather, it is delivered via an email. Upon receipt of the email invitation, the recipient initiates an Instant Messaging conversation with the

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sender" (page 2, paragraph [0016]). Additionally, *Bernstein* discloses "[t]he present invention also details the process whereby users may indicate that presence detection is allowed only to certain individuals simply by sending those individuals an email/IM invitation… This means that if Joe sends Jane an IM-enhanced email, Jane would be able to communicate to Joe through that email, but if Jane used the standalone Instant Messaging service, she may not [be] able to detect Joe's presence, assuming Joe has 'total privacy' selected" (page 2, paragraph [0017]).

As indicated in these passages, *Bernstein* appears to disclose that an email is sent in order to initiate an Instant Message. Additionally, *Bernstein* appears to disclose that a user can limit the dissemination of his/her presence information. This, however, is completely different than claim 1 for at least the reason that sending an IM-enhanced email and limiting presence information is vastly different than the cause-effect scenario of initiating an IM session in response to determining that a contact is present. Nowhere in *Bernstein* is there any suggestion of initiating an IM session in response to determining that a contact is present. For at least this reason, claim 1 is allowable.

B.   Claim 9 is Allowable Over *Bernstein*

The Office Action indicates that claim 9 stands rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Publication Number 2004/0128356 ("*Bernstein*"). Applicants respectfully traverse this rejection on the grounds that *Bernstein* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 9 recites:

> A system comprising:
> means for determining an Internet presence of a contact identified in an email message; and
> means for initiating an instant messaging (IM) chat session with the contact *in response to determining that the contact is present*.
> *(Emphasis added)*

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Applicants respectfully submit that claim 9 is allowable for at least the reason that *Bernstein* fails to disclose, teach, or suggest a "system comprising… means for initiating an instant messaging (IM) chat session with the contact **in response to determining that the contact is present**" as recited in claim 9. More specifically, *Bernstein* discloses an "Instant Messaging session [that] is initiated via email… the initial chat request is not delivered via an Instant Message, rather, it is delivered via an email. Upon receipt of the email invitation, the recipient initiates an Instant Messaging conversation with the sender" (page 2, paragraph [0016]). Additionally, *Bernstein* discloses "[t]he present invention also details the process whereby users may indicate that presence detection is allowed only to certain individuals simply by sending those individuals an email/IM invitation… This means that if Joe sends Jane an IM-enhanced email, Jane would be able to communicate to Joe through that email, but if Jane used the standalone Instant Messaging service, she may not [be] able to detect Joe's presence, assuming Joe has 'total privacy' selected" (page 2, paragraph [0017]).

As indicated in these passages, *Bernstein* appears to disclose that an email is sent in order to initiate an Instant Message. Additionally, *Bernstein* appears to disclose that a user can limit the dissemination of his/her presence information. This, however, is completely different than claim 9 for at least the reason that sending an IM-enhanced email and limiting presence information is vastly different than the cause-effect scenario of initiating an IM session in response to determining that a contact is present. Nowhere in *Bernstein* is there any suggestion of initiating an IM session in response to determining that a contact is present. For at least this reason, claim 9 is allowable.

C.   Claim 10 is Allowable Over *Bernstein*

The Office Action indicates that claim 10 stands rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Publication Number 2004/0128356

("*Bernstein*"). Applicants respectfully traverse this rejection on the grounds that *Bernstein* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 10 recites:

> A system comprising:
> presence logic configured to determine an Internet presence of a contact identified in an email message; and
> chat-initiation logic configured to initiate an instant messaging (IM) chat session with the contact ***in response to determine that the contact is present***.
> ***(Emphasis added)***

Applicants respectfully submit that claim 10 is allowable for at least the reason that *Bernstein* fails to disclose, teach, or suggest a "system comprising... chat-initiation logic configured to initiate an instant messaging (IM) chat session with the contact ***in response to determine that the contact is present***" as recited in claim 10. More specifically, *Bernstein* discloses an "Instant Messaging session [that] is initiated via email... the initial chat request is not delivered via an Instant Message, rather, it is delivered via an email. Upon receipt of the email invitation, the recipient initiates an Instant Messaging conversation with the sender" (page 2, paragraph [0016]). Additionally, *Bernstein* discloses "[t]he present invention also details the process whereby users may indicate that presence detection is allowed only to certain individuals simply by sending those individuals an email/IM invitation... This means that if Joe sends Jane an IM-enhanced email, Jane would be able to communicate to Joe through that email, but if Jane used the standalone Instant Messaging service, she may not [be] able to detect Joe's presence, assuming Joe has 'total privacy' selected" (page 2, paragraph [0017]).

As indicated in these passages, *Bernstein* appears to disclose that an email is sent in order to initiate an Instant Message. Additionally, *Bernstein* appears to disclose that a user can limit the dissemination of his/her presence information. This, however, is completely different than claim 10 for at least the reason that sending an IM-enhanced

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email and limiting presence information is vastly different than the cause-effect scenario

of initiating an IM session in response to determining that a contact is present. Nowhere

in *Bernstein* is there any suggestion of initiating an IM session in response to

determining that a contact is present. For at least this reason, claim 10 is allowable.

D. Claim 14 is Allowable Over *Bernstein*

The Office Action indicates that claim 14 stands rejected under 35 U.S.C.

§102(e) as allegedly being anticipated by U.S. Publication Number 2004/0128356

("*Bernstein*"). Applicants respectfully traverse this rejection on the grounds that

Bernstein does not disclose, teach, or suggest all of the claimed elements. More

specifically, claim 14 recites:

> A computer-readable storage medium comprising:
> computer-readable code adapted to instruct a programmable device to determine an Internet presence of a contact from an email message; and
> computer-readable code adapted to instruct a programmable device to initiate an instant messaging (IM) chat session with the contact *in response to determining that the contact is present*.
> *(Emphasis added)*

Applicants respectfully submit that claim 14 is allowable for at least the reason

that *Bernstein* fails to disclose, teach, or suggest a "computer-readable storage medium

comprising… computer-readable code adapted to instruct a programmable device to

initiate an instant messaging (IM) chat session with the contact *in response to*

determining that the contact is present" as recited in claim 14. More specifically,

Bernstein discloses an "Instant Messaging session [that] is initiated via email… the initial

chat request is not delivered via an Instant Message, rather, it is delivered via an email.

Upon receipt of the email invitation, the recipient initiates an Instant Messaging

conversation with the sender" (page 2, paragraph [0016]). Additionally, *Bernstein*

discloses "[t]he present invention also details the process whereby users may indicate

that presence detection is allowed only to certain individuals simply by sending those individuals an email/IM invitation… This means that if Joe sends Jane an IM-enhanced email, Jane would be able to communicate to Joe through that email, but if Jane used the standalone Instant Messaging service, she may not [be] able to detect Joe's presence, assuming Joe has 'total privacy' selected" (page 2, paragraph [0017]).

As indicated in these passages, *Bernstein* appears to disclose that an email is sent in order to initiate an Instant Message. Additionally, *Bernstein* appears to disclose that a user can limit the dissemination of his/her presence information. This, however, is completely different than claim 14 for at least the reason that sending an IM-enhanced email and limiting presence information is vastly different than the cause-effect scenario of initiating an IM session in response to determining that a contact is present. Nowhere in *Bernstein* is there any suggestion of initiating an IM session in response to determining that a contact is present. For at least this reason, claim 14 is allowable.

E.   **Claims 2 – 8, 11 – 13 and 15 – 21 are Allowable Over *Bernstein***

The Office Action indicates that claims 2 – 8, 11 – 13 and 15 – 21 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Publication Number 2004/0128356 ("*Bernstein*"). Applicants respectfully traverse this rejection on the grounds that *Bernstein* does not disclose, teach, or suggest all of the claimed elements. More specifically, dependent claims 2 – 8 are believed to be allowable for at least the reason that these claims depend from and include the elements of allowable independent claim 1. Dependent claims 11 – 13 are believed to be allowable for at least the reason that these claims depend from and include the elements of allowable independent claim 10. Further, dependent claims 15 – 21 are believed to be allowable for at least the reason that these claims depend from and include the elements of

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allowable independent claim 14. *In re Fine, Minnesota Mining and Mfg.Co. v.*

Chemque, Inc., 303 F.3d 1294, 1299 (Fed. Cir. 2002).

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and Official Notice, or statements interpreted similarly, should not be considered well-known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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